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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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41505	7590	08/23/2005	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			HO, THOMAS M	
			ART UNIT	PAPER NUMBER
			2134	
DATE MAILED: 08/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,371

Applicant(s)

PEINADO, MARCUS

Examiner

Thomas M. Ho

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are pending.

Response to Arguments

2. Applicant has argued the following on page 15:

Notably, the Saito reference is entirely silent with regard to any license or sub-license being employed to convey the encrypted content keys, as is required by claim 1. At any rate, neither the first Saito user nor any other actor in the Saito reference obtains a content key (KD) in an encrypted form, decrypts the encrypted content key (K17) to produce the content key (K.E8, and encrypts the content key (10) according to the public key (PU1) of a first device (PUI (K18), as is required by claim 1. At most, each Saito user decrypts an encrypted content key, but by no means does such Saito user encrypt the decrypted content key according to the public key (PU1) of any other user or device. Instead, the Saito reference teaches that only the data center performs any encryption of a content key according to a public key.

It is the Examiner's understanding that to one of ordinary skill in the art, all that a digital license should contain is the content decryption key. Identifying information may or may not be provided, but it is the content decryption key which allows access to the content to which a user is trying to obtain content. Applicant has recited a digital license in his claim as follows:

PD

Obtaining a digital license corresponding to the content, the digital license including the content key(KD) therein in an encrypted form. Such definition is consistent with the Examiner's understanding of the art.

The Examiner finds no further limitations in the claim as to what a digital license comprises. Consequently, the Examiner maintains that Saito's digital construct which contains a content key may also be similarly characterized as a digital license.

Moreover, no Saito user composes any sub-license corresponding to and based on any obtained license to include (PU(KD)), as is required by claim 1. Again, only the Saito data center is disclosed as encrypting any content keys, and not any Saito user

The Examiner has not been able to find any recitation in the claims from which it is required that a user be required as encrypting the content keys. Instead, the Applicant appears to treat each entity as a first device, or second device, which is significantly broader than a limitation that a user perform a certain action.

These arguments are believed to be the crux of Applicant's arguments. Because the limitations are not directly stated in the claims, the Examiner is to take on the "broadest reasonable interpretation" in understanding the claims and Applicant's arguments are unpersuasive. The rejections are maintained.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-6, 8-9, 11, 13-14 is rejected under 35 U.S.C. 102(b) as being anticipated by Saito, US patent 6,002,772.

In reference to claim 1:

Saito discloses a method for rendering encrypted digital content on a first device having a public key (PU1) and a corresponding private key (PR1), the digital content being encrypted according to a content key (KD), the method comprising:

- Obtaining a digital license corresponding to the content, the digital license including the content key (KD) therein in an encrypted form, where the digital license is obtained by generating at the data management center the combination of content keys Ks1 with the content name, first user data, and first user public key. (Column 6, lines 60-67)
- Decrypting the encrypted content key (KD) from the digital license to produce the content key (KD), where the content keys are decrypted from the digital license. (Column 7, lines 5-10)

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- Obtaining from the first device the public key thereof (PU1), where the first device is the first user, and the data management center obtains the public key where the user presents the key and requests distribution of secret keys. (Column 6, lines 43-47)
- Encrypting the content key (KD) according to the public key (PU1) of the first device (PU1 (KD)), where the content key Ks1 is encrypted with the public key. (Column 6, lines 60-67)
- Composing a sub-license corresponding to and based on the obtained license, the sub license including (PU1 (KD)), and transferring the composed sublicense to the first device, wherein the first device can decrypt (PU1 (KD)) with the private key thereof (PR1) to produce the content key (KD), and can render the encrypted content on the first device with the produced content key(KD), where the sub-license is the encrypted secret keys which are transferred to the first device, or first user. (Column 7, lines 2-5), and the sub-license may then be decrypted to produce the content key, Ks1.

In reference to claim 3:

Saito discloses the method of claim 1 further comprising transferring the content to the first device, where the data content is supplied to the first user. (Column 5, lines 14-20)

In reference to claim 4:

Saito discloses the method of claim 1 for rendering encrypted digital content on a first device having a digital rights management system(DRM), the DRM system having the public key(PU1),

where the DRM is the system used in Saito (Column 6, lines 20-22) and the corresponding private key (PR1), the method comprising:

- Obtaining from the first device the public key of the DRM system thereof (PU1), where the user presents the key and requests distribution of secret keys. (Column 6, lines 43-47)
- Encrypting the content key (KD) according to the public key (PU1) of the DRM system of the first device (PU1 (KD)), where the content key Ks1 is encrypted with the public key. (Column 6, lines 60-67)
- Composing a sub-license corresponding to and based on the obtained license, the sub-license including (PU1 (KD)), and transferring of the composed sub-license to the first device, wherein the DRM system of the first device can decrypt (PU1 (KD)) with the private key thereof (PR1) to produce the content key (KD), and can render the encrypted content on the first device with the produced content key (KD), where the sub-license is the encrypted secret keys which are transferred to the first device, or first user. (Column 7, lines 2-5), and the sub-license may then be decrypted to produce the content key, Ks1.

In reference to claim 5:

Saito discloses the method of claim 1 comprising:

- Obtaining the digital license and storing the obtained digital license on a second device, where the digital license is combination of the Cks2Kb2, and Cks3kb2, and where the second device is the second user (Column 9, lines 8-17)

- Decrypting the encrypted content key (KD) from the digital license on the second device to produce the content key (KD), where the content keys are decrypted (Column 9, lines 19-26)
- Obtaining from the first device the public key thereof (PU1), where the first user presents the public key and the data center obtains it from the first user in this manner. (Column 6, lines 43-47)
- Encrypting the content key (KD) according to the public key (PU1) of the first device (PU1 (KD)), where the content key Ks1 is encrypted with the public key. (Column 6, lines 60-67)
- Composing a sub-license corresponding to and based on the obtained license, the sub-license including (PU1 (KD)), and transferring the composed sub-license from the second device to the first device, wherein the first device can decrypt (PU1 (KD)) with the private key thereof (PR1) to produce the content key (KD), and can render the encrypted content on the first device with the produced content key(KD), where the sub-license is the encrypted secret keys which are transferred to the first device, or first user. (Column 7, lines 2-5), and the sub-license may then be decrypted to produce the content key, Ks1.

In reference to claim 6:

Saito discloses the method of claim 5 wherein the second device has a public key (PU2) and a corresponding private key (PR2), the method comprising:

- Obtaining a digital license corresponding to the content, the digital license including the content key (KD) encrypted according to the public key (PU2) of the second device

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(PU2 (KD)), where the content key is encrypted with a second public key and where the digital license is combination of the Cks2Kb2, and Cks3kb2, and where the second device is the second user (Column 9, lines 8-17)

- Decrypting (PU2(KD)) from the digital license according to the private key (PR2) of the second device to produce the content key (KD), where the content keys are decrypted (Column 9, lines 19-26)

In reference to claim 8:

Saito (Column 7, lines 15-20) discloses the method of claim 1 wherein, the first device is a portable device, where the device is an IC card or PCMCIA card.

In reference to claim 9:

Saito discloses the method of claim 1 wherein obtaining from the first device the public key record thereof(PU1) comprises receiving a certificate from the first device within which is (PU1), where the user presents the key along with user data. (Column 6, lines 43-47), and it is understood in the art that a digital certificate typically comprises user identification data and the public key.

In reference to claim 11:

Saito discloses the method of claim 9 comprising receiving a certificate from the first device within which is (PU1) and information relating to the first device, where the user presents the

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key along with user data. (Column 6, lines 43-47), and it is understood in the art that a digital certificate typically comprises user identification data and the public key.

Claim 13 is rejected for the same reasons as claim 11.

In reference to claim 14:

Saito discloses the method of claim 11 further comprising obtaining (PU1 (KD)) from the transferred sub-license(Column 7, lines 2-5), applying (PR1) to (PU1 (KD)) to obtain the content key (KD) , and applying (KD) to decrypt the encrypted content, all by the first device. (Column 7, lines 5-13)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 7, 10, 12, 15-22 are rejected in view of Sato, US patent 6,002,772.

In reference to claim 2:

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Saito fails to disclose the method of claim 1 further comprising, prior to composing the sub-license and transferring the composed sub-license to the device, checking the obtained license to determine that such license permits issuance of the sub-license to the device.

The Examiner takes official notice that authenticating users through user submitted personal information was well known in the art at the time of invention.

Saito however discloses that information regarding the user identity is submitted. While it is not explicitly stated that the data management center users this information to verify the identity of the user, it would have been obvious to one of ordinary skill in the art at the time of invention to authenticate the user with the user submitted data to make ensure the content wouldn't be submitted to someone without the proper credentials.

In reference to claim 7:

Saito fails to explicitly discloses the method of claim 5 wherein the second device is a computer.

The Examiner takes official notice that using computers for data content distribution was well known in the art at the time of invention.

It would have been obvious to one of ordinary skill in the art to distribute the data to a computer, provided the extra processing power a computer has over other electronic devices such as calculators.

In reference to claim 10:

Saito fails to disclose the method of claim 9 further comprising comparing the received certificate against a revocation list to ensure that the certificate has not been compromised.

The Examiner takes official notice that checking to see if a certificate has been compromised against a list was well known at the time of invention. This technology, known as CRLs or certificate revocation lists is a list that is passed around or stationary on a server, that computers may use to determine the "Freshness" of a given certificate.

Examples of prior art that use CRLs are patents:

5717757, 5666416, 5793868.

It would have been obvious to one of ordinary skill in the art at the time of invention to check if a certificate was valid against a list in order to determine whether the information the user was providing was up to date.

Claim 12 is rejected for the same reasons as claim 2.

In reference to claim 15:

Saito discloses a method for rendering encrypted digital content on a first device having a public key (PU1) and a corresponding private key (PR1), the digital content being encrypted according to a content key (KD), the method comprising:

- Providing the public key (PU1) to a second device, wherein the second device obtains a digital license corresponding to the content, the digital license including the content key

(KD), encrypts the content key (KD) according to the public key(PU1) of the first device (PU1, (KD)) and composes a sublicense corresponding to and based on the obtained license, the sub-license corresponding to and based on the obtained license, the sub-license including (PU1, (KD)), where the second device is the data center, and where the

- Receiving the composed sub-license from the second device, where the composed sub-license is created and sent to the user. (Column 7, lines 3-5)
- Obtaining (PU1 (KD)) from the received sub-license (Column 7, lines 5-12)
- Applying (PR1) to (PU1 (KD)) to obtain the content key(KD) (Column 7, lines 5-12)
- Applying (KD) to decrypt the encrypted document, where Ks1 is used to decrypt the content. (Column 6, lines 43-46)

Saito fails to explicitly disclose rendering the decrypted document

The Examiner takes official notice that rendering digital content was well known at the time of invention.

It would have been obvious to one of ordinary skill in the art to render to the content of Saito in order to take advantage of the fact that that is what the content is there for.

In reference to claim 16:

Saito discloses the method of claim 15 further comprising receiving the content from the second device, where the second device is the data center, and the content is received by the first user. (Column 5, lines 15-20)

Claim 17 is rejected for the same reasons as claim 15.

Claim 18 is rejected for the same reasons as claim 7.

Claim 21 is rejected for the same reasons as claim 2, where the second device is the data center.

Claim 19 is rejected for the same reasons as claim 8.

Claim 20 is rejected for the same reasons as claim 11, where the second device is the data center.

Claim 22 is rejected for the same reasons as claim 11, where the second device is the data center.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of the final action and the advisory action is not mailed under after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension pursuant to 37 CFR

1.136(A) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication from the examiner should be directed to Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571)272-3838.


The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

General Information/Receptionist Telephone: 571-272-2100 Fax: 703-872-9306
Customer Service Representative Telephone: 571-272-2100 Fax: 703-872-9306

TMH

August 8th, 2005


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